

REMARKS

Claims 1 – 53 and 55 are pending.

Claim 54 was cancelled.

No claims are amendeded or added in this response; however, as discussed below, Applicants' amendments presented in a response filed March 28, 2007, were found to be noncompliant. Therefore, the relevant amendment to claim 21 is re-presented here.

Reconsideration of the application is requested.

Specification

Applicants gratefully acknowledge the Examiner's entry of the substitute specification submitted on March 28, 2007.

Amendments to the Claims

In the outstanding Final Office Action, the Patent Office noted that Applicants' amendment filed 3/28/2006 proposed amendments to claims 40-53 that did not comply with 37 CFR § 1.173(b). Claims 40-53 were first presented with the originally filed reissue application. These claims were not amended in Applicants' amendment filed 3/28/2006; however, these claims were listed and identified as "original" claims. As no amendments were made, these claims should not have been listed (37 CFR § 1.173(b)(2)); rather Applicants should have merely noted, as they do herein, that these claims are "pending."

The Patent Office also noted that in the amendment to claim 21 the deleted word "and" should have been shown in brackets, not strikethrough. Applicants note that the deleted semicolon should also have been shown in brackets. Properly amended claim 21 is re-presented here.

In addition to the noncompliant issues noted by the Examiner, Applicants note that claim 54 was canceled in Applicants' 3/28/2006 response. However, the current Office Action indicates that claim 54 is still pending. Applicants request that claim 54 be canceled.

Allowable Subject Matter

Applicants gratefully acknowledge the Examiner's statement indicating that claims 3, 11-14, 16-19, 25-28, 30, 36-37, 39, 42, and 51-54 would be allowable if rewritten in independent form. First, Applicants note that claim 54 has been canceled. Second, Applicants respectfully defer redrafting the allowable claims in independent form pending a final resolution regarding the patentability of the remaining claims.

§ 103 Rejections

(A) Claims 1-2, 7-9, 22-24, 31-32, 35, 38, 40-41, and 47-50 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Johnson (5178924) ("Johnson1").

Applicants appreciate the Examiner's consideration of Applicants' arguments presented 12/19/2005 and 3/28/2006. Applicants respectfully submit the following additional comments in response to the discussion of these arguments as set forth in the pending Office Action.

Independent claim 1 provides an adhesive tape assembly requiring a roll stability layer comprising an ethylene vinyl acetate (EVA). Similarly, independent claims 22, 35, 38, 40, and 47 provide articles comprising a roll stability layer comprising EVA. The Patent Office acknowledges that Johnson1 fails to teach a backside stability layer comprising EVA. To overcome this admitted deficiency, the Patent Office asserts that

- (1) Johnson1 discloses that the backside of the release liner is provided with a layer of EAA to provide roll stability; and
- (2) Johnson1 discloses that the release material can be ethylene acrylic acid (EAA) or EVA. From this, the Patent Office concludes that "it would have been obvious to one of ordinary skill in the art to use EVA as the release material, instead of EAA, because the two are functionally equivalent as the friction reducing release material and would provide roll stability." (Office Action mailed September 16, 2006, and maintained in the Final Office Action of April 23, 2007, emphasis added.)

Applicants respectfully submit that the Patent Office's reliance on the purported functional equivalence of EAA and EVA as the basis for its obviousness rejection is contrary to Patent Office procedures and governing precedent.

MPEP § 2144.06 addresses the issue of “Substituting Equivalents Known for the Same Purpose.” According to the MPEP, “In order to rely on equivalence as a rational supporting an obviousness rejection the equivalence must be recognized in the prior art, and cannot be based on ... the mere fact that the components at issue are functional or mechanical equivalents.” (Emphasis added, citing *In re Ruff*, 256 F.2d 590, 118 USPQ 340 (CCPA 1958).)

When considering the description in Johnson1, it is important to maintain the clear distinction between the “release layer” and the “friction enhancing agent.” Applicants note that the passage cited by the Patent Office which purportedly teaches the functional equivalence of EAA and EVA (i.e., col. 4, lines 54-66) merely provides “illustrative examples of homopolymers and copolymers that may be used in the release layer of the release liner”. Applicants respectfully submit that this list is similar to a Markush group, and as held in *In re Ruff* “it is no longer possible to indulge in a presumption that members of a Markush group are recognized by anyone to be equivalents except as they possess at least one property in common which is mainly responsible for their function in the claimed relationship.” (256 F.2d at 599, 118 USPQ at 348.)

At best, this text of Johnson1 might suggest that the items included may be useful as release layers; however, even if the Patent Office were to maintain its position that Johnson1 discloses that the listed materials are functionally equivalent as release materials, the Patent Office has failed to show how Johnson1 describes, teaches, or suggests that any of the materials on the list are functionally equivalent for any other purpose. Specifically, the Patent Office has failed to show how Johnson1 describes, teaches, or suggests that EAA and EVA are functionally equivalent as friction enhancing agents.

For at least these reasons, the rejection of independent claims 1, 22, 35, 38, 40, and 47 under 35 USC § 103(a) as being unpatentable over Johnson (5178924) is unwarranted and should be withdrawn. Claims 2, 7-9, and 31-32 each depend from claim 1 and add patentable features thereto. Similarly, claims 23-24 depend from claim 22; claim 41 depends from claim 40, and claims 48-50 depend from claim 47; wherein each dependent claim adds patentable features to its corresponding independent claim. As each independent claim is patentable for at least the reasons discussed above, each of these dependent claims is likewise patentable.

- (B) Claims 6, 10, 15, 20-21, 29, 33-34, and 45-46 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Johnson1 in view of Johnson (5167995) (“Johnson2”).

Independent claims 15, 21, and 29 provide articles that require a roll stability comprising an EVA. As discussed above in Section (A), the Patent Office has failed to show how Johnson1 renders such articles obvious. Applicants respectfully submit that the Patent Office has failed to show how Johnson2 overcomes these deficiencies.

For at least these reasons, the rejection of independent claims 15, 21 and 29 under 35 USC § 103(a) as being unpatentable over Johnson1 in view of Johnson (5167995) is unwarranted and should be withdrawn.

Claims 6, 10, and 20 depend from claim 1, claims 33 and 34 depend from claim 21, and Claims 45 and 46 depend from claim 40; wherein each of the dependent claims adds patentable features to its corresponding dependent claim. Each of independent claims 1, 21, and 40 are patentable for at least the reasons stated above; thus, each of the dependent claims is likewise patentable.

- (C) Claims 4-5 and 43-44 stand rejected under 35 USC § 103(a) as purportedly being unpatentable over Johnson1 in view of Reinders (6037028).

Claims 4-5 depend from claim 1 and add patentable features thereto. Similarly, claims 43-44 depend from claim 40 and add patentable features thereto. Claims 1 and 40 are patentable over Johnson1 for at least the reasons stated above in Section (A). Applicants respectfully submit that the Patent Office has failed to show how Reinders overcomes the deficiencies of Johnson1.

For at least these reasons, the rejection of claims 4-5 and 43-44 under 35 USC § 103(a) as purportedly being unpatentable over Johnson1 in view of Reinders (6037028) is unwarranted and should be withdrawn.

- (D) Claim 55 stands rejected under 35 USC § 103(a) as purportedly being unpatentable over Johnson1 in view of Reinders (6037028).

Claim 55 depends from claim 21. Claim 21 is patentable over claim Johnson1 for at least the reasons discussed above in Sections (A) and (B). Applicants respectfully submit that the Patent Office has failed to show how Reinders overcomes the deficiencies of Johnson1. For at least these reasons, the rejection of claim 55 under 35 USC § 103(a) as purportedly being unpatentable over Johnson1 in view of Reinders (6037028) is unwarranted and should be withdrawn.

In view of the above, it is submitted that the application is in condition for allowance. Reconsideration of the application and allowance of all pending claims is respectfully requested.

If any issues remain, Applicants request a telephone interview to more fully understand the examiner's position and advance this case to issuance.

Respectfully submitted,

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